

1 RODNEY J. JACOB, ESQ.
2 DANIEL M. BENJAMIN, ESQ.
3 JENNIFER A. CALVO-QUITUGUA, ESQ.
4 **CALVO & CLARK, LLP**
5 Attorneys at Law
655 South Marine Corps Drive, Suite 202
Tumuning, Guam 96913
Telephone: (671) 646-9355
Facsimile: (671) 646-9403

7 CHRISTOPHER E. CHALSEN, ESQ.
8 MICHAEL M. MURRAY, ESQ.
9 LAWRENCE T. KASS, ESQ.
10 MILBANK, TWEED, HADLEY & MCCLOY LLP
11 1 Chase Manhattan Plaza
New York, New York 10005
Telephone: (212) 530-5000
Facsimile: (212) 822-5796

12 *Attorneys for Defendants*
13 FUJITSU LIMITED AND
FUJITSU MICROELECTRONICS AMERICA, INC.

IN THE UNITED STATES DISTRICT COURT

DISTRICT OF GUAM

17 NANYA TECHNOLOGY CORP. and
NANYA TECHNOLOGY CORP. U.S.A.

CIVIL CASE NO. 06-CV-00025

18 Plaintiff

**DEFENDANTS' OPPOSITION TO
PLAINTIFFS' MOTION TO EXCEED
NUMBER OF INTERROGATORIES
AND REQUESTS FOR ADMISSIONS**

21 FUJITSU LIMITED, FUJITSU
MICROELECTRONICS AMERICA, INC.

Defendants

1 Defendants Fujitsu Limited and Fujitsu Microelectronics America, Inc. hereby oppose
 2 Plaintiffs' Motion to Exceed Number of Interrogatories and Requests for Admissions ("Motion")
 3 pursuant to the District Court of Guam's Local Rules of Practice, L.R. 33.1(a). Plaintiffs' Motion
 4 should be denied because (1) Plaintiffs have not complied with this Court's Local Rules or the
 5 Federal Rules of Civil Procedure; (2) the requested relief would grant Plaintiffs a "blank check"
 6 to harass Defendants and abuse the discovery process; and (3) the requested relief would
 7 undoubtedly create significant discovery disputes and increase the burden on this Court, not
 8 reduce it as Plaintiffs allege.

9

10 **I. PLAINTIFFS HAVE NOT COMPLIED WITH THE LOCAL RULES**

11 Local Rule 33.1 provides (emphasis added):

12 (a) Limitation on Number of Interrogatories and Requests for Admission. No
 13 party shall serve more than one set of interrogatories or requests for admission
 14 on any other party without leave of court. Interrogatories or requests for
 15 admission shall not exceed twenty-five (25) in number, counting any subparts or
 16 subquestions as individual questions. Subparts or subquestions of any
 17 interrogatory shall relate directly to the subject matter of the interrogatory. Any
 18 party desiring to serve additional interrogatories shall submit to the Court a
 19 written memorandum setting forth the proposed additional interrogatories or
 20 requests for admission and the reasons establishing good cause for their use.

21 Thus, Local Rule 33.1 plainly limits the number of interrogatories and requests for
 22 admission to 25 each. Although that number can be exceeded in complex cases, there is a
 23 straightforward and reasonable procedure for requesting such an increase, namely (1) the
 24 additional interrogatories must be *set forth* in a memorandum to the Court and (2) reasons must
 25 be provided that establish *good cause* for *each* of the additional interrogatories and requests for
 26 admission.

27 Instead of following the local rules, Plaintiffs seek a blank check to serve *nine hundred*
 28 (900) interrogatories as well as *nine hundred* (900) requests for admission, raising the combined
 29 total from fifty (50) allowed by the rules to *one thousand eight hundred* (1,800), a more than
 30

1 3,000% increase above the allowed limits.¹

2 Plaintiffs have not set forth *any* of the proposed additional interrogatories or requests for
 3 admission as required by the rules. Instead, Plaintiffs essentially ask the Court to approve, in
 4 advance and without review, the voluminous additional requests because the “subject areas have
 5 been set forth.” (Motion at 7.) However, the plain language of Local Rule 33.1 does not allow a
 6 party to merely set forth “subject areas,” but requires that the additional interrogatories or
 7 requests for admission themselves be “set forth”.

8 Courts have consistently required a party requesting additional interrogatories to
 9 demonstrate a need by showing the *specific content* of the proposed interrogatories. *See, e.g.*,
 10 *Valdez v. Ford Motor Co.*, 134 F.R.D. 296, 299 (D. Nev. 1991) (requiring parties to compile their
 11 additional interrogatories for the court before making a decision on whether the additional
 12 interrogatories are reasonable); *E. & J. Gallo Winery*, 04-CV-5153 OWW DLB, 2006 U.S. Dist.
 13 LEXIS 84027, *6 (E.D. Cal. Nov. 8, 2006) (interpreting Northern District of California Local
 14 Rule 33-3, which is similar to Guam Local Rule 33.1, to require “a request to propound additional
 15 interrogatories to explain in detail why it is necessary to propound each additional question.”).

16 Not only have Plaintiffs failed to provide the Court with their proposed additional
 17 interrogatories or requests for admission, they have also not set forth the “reasons establishing
 18 good cause for their use.” L.R. 33.1. A party requesting leave to serve additional interrogatories
 19 must make a “particularized showing” of good cause for why the additional discovery is
 20 necessary. *E. & J. Gallo Winery*, 2006 U.S. Dist. LEXIS 84027, at *6; *Morrow v. Leo Burnett
 21 Inc.*, No. C 04-0931 MMC (JL), 2005 U.S. Dist. LEXIS 43437, *8 (N.D. Cal. Feb. 4, 2005)
 22 (citation omitted). Because Plaintiffs have not even presented the interrogatories or requests for
 23 admission that they seek, they have not even attempted to make the required particularized

24
 25 ¹ Understandably, Plaintiffs’ Motion does not expressly admit that the requested relief
 26 would result in 1,800 requests, but that is plainly what they seek. Plaintiffs ask for an “initial set”
 27 of 25 interrogatories and 25 requests for admission for each patent in suit and then a “second set”
 28 with an additional 25 interrogatories and 25 requests for admission, again for each patent in suit.
 (Motion at 2.) There are 18 patents in suit and, *e.g.*, 25 interrogatories x 2 sets x 18 patents = 900.

1 showing of good cause why *each* such additional request is necessary, demonstrating the
 2 premature nature of this Motion.

3 Accordingly, because Plaintiffs have (1) failed to set forth any of the requested additional
 4 interrogatories or requests for admission or (2) provide a particularized showing of good cause for
 5 each such additional interrogatory, the Motion should be denied.

6

7 **II. IN ADDITION TO NOT SATISFYING THE LOCAL RULES, PLAINTIFFS'**
8 "FIVE REASONS" FOR THE ADDITIONAL REQUESTS ARE WHOLLY
9 INSUFFICIENT FOR THE EXTRAORDINARY RELIEF REQUESTED

10 Instead of following the procedure set forth in the local rules for additional interrogatories
 11 and requests for admission Plaintiffs present five reasons that allegedly justify the extraordinarily
 12 large number of requests they seek. But none of these reasons justify the relief.

13 First, Plaintiffs state that the "primary reason" for the additional requests is that they will
 14 "greatly aid claim construction." (Motion at 2-3.) Plaintiffs then launch into a discussion of the
 15 importance of claim construction (which is undisputed), but completely fail to specify how their
 16 proposed additional discovery requests will help narrow or resolve issues of claim construction.
 17 In fact, exchanging hundreds of interrogatories is highly unlikely to result in progress on claim
 18 construction and is *not* the procedure for accomplishing claim construction set forth in the Patent
 19 Local Rules of the Northern District of California, which Plaintiffs have suggested that this Court
 adopt.

20 Specifically, under the Northern District's Patent Local Rules, the parties simultaneously
 21 exchange a list of claim terms, phrases, or clauses which that party contends should be construed
 22 by the Court. *See* N.D. Cal. Pat. L. R. 4-1(a). The parties then meet and confer "for the purpose
 23 of finalizing this list, narrowing or resolving differences." N.D. Cal. Pat. L. R. 4-1(b). Then the
 24 parties will exchange preliminary claim constructions and extrinsic evidence for terms on the list.
 25 *See* N.D. Cal. Pat. L. R. 4-2(a)(b). The parties then must meet again "for the purpose of
 26 narrowing the issues and finalizing preparation of a Joint Claim Construction and Prehearing
 27 Statement." N.D. Cal. Pat. L. R. 4-2(c). This all happens without interrogatories or requests for

1 admission and is a far more effective process for focusing claim construction issues than that
 2 suggested by Plaintiffs.

3 Plaintiffs allege that the relief sought will relieve the Court of the burden of “investing an
 4 extraordinary amount of time and resources trying to flush out and flesh out the meaning of
 5 critical terms and narrowing the issues.” (Motion at 2.) But in the normal claim construction
 6 process, as outlined above, it is the parties that must flesh out the claim construction issues before
 7 they are submitted to the Court for decision. Further, if the parties exchange some 3,600²
 8 interrogatories and requests for admission, it is inevitable that numerous disputes will arise over
 9 the sufficiency of the answers and these disputes are far more likely to burden the Court than the
 10 normal claim construction process.³ In addition, Plaintiffs’ process is likely to distract the parties
 11 from claim construction, not contribute toward it.

12 The “second reason” allegedly justifying the requests is that the limit in Local Rule 33.1
 13 allegedly “does not permit a fair and reasonable inquiry into Fujitsu and FMA’s patent misuse,
 14 the antitrust issues and circumstances under which licenses are granted.” (Motion at 4-5.) This
 15 “reason” is not explained at all. Interrogatories and requests for admission are clearly not the
 16 only discovery tool available to Plaintiffs. Indeed, Plaintiffs have already served more than 1,500
 17 document requests and are requesting depositions. Plaintiffs have not explained why they cannot
 18 obtain the required information within the bounds of the normal discovery process.⁴

19 The “third reason” is that the additional discovery requests will improve chances for
 20 settlement of the case, suggesting that these requests will somehow reduce alternate claim
 21 constructions or interpretations by the parties. Once again, Plaintiffs fail to specify how the

22 ² If the Court should grant Plaintiff’s request for 1,800 requests, then Defendants would
 23 request equal treatment, bringing the total to 3,600.

24 ³ In fact, the first set of document requests served by Plaintiffs has already resulted in
 25 two separate (baseless) motions to compel, indicating that further discovery disputes are likely.
 (See Motion to Compel, Dkt. No. 113 and Motion to Compel, Dkt. No. 132.)

26 ⁴ In the California case Judge Wilken has noted that if this case is transferred to N.D.
 27 California, she is likely to sever and stay the antitrust issues until the patent issues are resolved.
 28 Defendants will ask this Court to follow a similar process, potentially obviating the need for this
 discovery.

1 additional requests accomplish such a task. In fact, it seems to be Plaintiffs' strategy to try and
2 force a settlement by bombarding Defendants with extraordinary volumes of discovery. As noted
3 above, more than 1,500 document requests have already been served. Plaintiffs now seek to "pile
4 on" with many hundreds of interrogatories and requests for admission. This is not a legitimate
5 way to try and bring about settlement.

6 The fourth reason Plaintiffs cite is a need for jurisdictional discovery. Plaintiffs attach
7 exhibits with receipts for a small handful of products allegedly purchased on Guam that were
8 allegedly sold by Defendants. But Plaintiffs utterly fail to explain why they need hundreds and
9 hundreds of interrogatories and requests for admission to establish the source of these six or seven
10 products. Document requests, which have already been served, will provide Plaintiffs with a list
11 of Defendants' products as well as a list of its customers. The needed information can thus be
12 obtained without such a drastic departure from the local and federal rules.

13 Plaintiffs state as the fifth and final reason to grant their Motion that it should be granted
14 simply because "it is permissible." Plaintiffs cite five cases for the proposition that district courts
15 have wide discretion over the discovery process, but none of the cited cases support the type of
16 relief requested here. *See Cornwell v. Electra Cent. Credit Union*, 439 F.3d 1018 (9th Cir. 2006)
17 (affirming district court ruling refusing to allow a moving party to reopen discovery where
18 movant had ample opportunity to collect the evidence prior to the close of discovery); *California*
19 *v. Campbell*, 138 F.3d 772 (9th Cir. 1998) (holding that defendants were not entitled to more time
20 to conduct discovery prior to a grant of summary adjudication); *Volk v. D.A. Davidson & Co.*, 816
21 F.2d 1046 (9th Cir. 1987) (upholding a district court decision to stay discovery); *Univ. of W. Va.*
22 *v. Van Voorhies*, 278 F.3d 1288, 1304 (Fed. Cir. 2002) (upholding a district court ruling denying
23 a motion to compel discovery because the moving party untimely noticed depositions of
24 witnesses known even before the litigation); and *Advanced Cardiovascular Systems, Inc. v.*
25 *Medtronics, Inc.*, 265 F.3d 1294 (Fed Cir. 2001) (upholding district court ruling refusing to allow
26 movant to obtain discovery into settlement negotiations).

27

28

1 Although Defendants do not dispute that this Court has the discretion to grant the
 2 requested relief, Plaintiffs have failed to cite *any* cases indicating why this Court *should* grant the
 3 relief. None of the cases Plaintiffs cite involve a court granting extra interrogatories or requests
 4 for admission, much less an outlandish request for many hundreds of additional interrogatories
 5 and requests for admission without even reviewing the requests in advance. In fact, not only do
 6 these cases not deal with decisions relating to whether or not additional interrogatories or requests
 7 for admission should be permitted, the two principal cases cited by Plaintiffs are cases in which
 8 courts denied expansion of the scope of discovery. *See Cornwell v. Electra Cent. Credit Union*,
 9 439 F.3d 1018, 1027 (9th Cir. 2006) (denying motion to reopen discovery) and *Univ. of W. Va. v.*
 10 *Van Voorhies*, 278 F.3d 1288, 1304 (Fed. Cir. 2002) (denying request to extend amount of time
 11 allotted for deposition).

12 Accordingly, none of Plaintiffs' "reasons" come close to justifying the outrageous
 13 increase that they seek in the discovery limits.

14 **III. PLAINTIFFS REQUEST IS UNREASONABLY BURDENSOME UNDER**
 15 **FEDERAL RULE OF CIVIL PROCEDURE 26(b)**

16 In deciding motions for leave to serve additional interrogatories, courts in this Circuit
 17 have applied the factors set forth in Federal Rule of Civil Procedure 26(b)(2). *See, e.g., E. & J.*
 18 *Gallo Winery*, 2006 U.S. Dist. LEXIS 84027 at *5; *Morrow*, 2005 U.S. Dist. LEXIS 43437 at *7.
 19 Rule 26(b)(2) states, in pertinent part:

20 The frequency or extent of use of the discovery methods otherwise permitted . . .
 21 by any local rule shall be limited by the court if it determines that: (i) the discovery
 22 sought is unreasonably cumulative or duplicative, or is obtainable from some other
 23 source that is more convenient, less burdensome, or less expensive; (ii) the party
 24 seeking discovery has had ample opportunity by discovery in the action to obtain
 25 the information sought; or (iii) the burden or expense of the proposed discovery
 26 outweighs its likely benefit, taking into account the needs of the case, the amount
 27 in controversy, the parties' resources, the importance of the issues at stake in the
 28 litigation, and the importance of the proposed discovery in resolving the issues.

1 (See also Guam General Rule 1.1(c) (stating that the District of Guam's local rules were designed
2 to "supplement the Federal Rules of Civil Procedure" and "shall be construed so as to be
3 consistent with the Federal Rules").)

4 As noted above, Plaintiffs seek a total of 900 interrogatories and 900 requests for
5 admission. Plaintiffs do not cite a single case to support such an extreme request. Even if
6 Plaintiffs were to comply with the local rules and provide the Court with their proposed
7 interrogatories and requests for admission, the total of 1,800 such requests would nonetheless be
8 unreasonably burdensome under the standard set forth in Fed. R. Civ. Pro. 26 (b). *See Francis v.*
9 *Marks*, 05-CV-01090 RSW/JTR, 2006 U.S. Dist. LEXIS 22576 (E.D. Ark. Apr. 18, 2006)
10 (denying a motion seeking 248 requests for admission as unreasonably burdensome despite the
11 complexity of issues in that case).

12

13 **IV. SIMILAR RELIEF WAS REQUESTED AND NOT GRANTED IN THE N.D. OF
CALIFORNIA CASE**

14 In the related case of *Fujitsu Ltd. v. Nanya Tech. Corp.*, No. 4:06-cv-06613 (CW),
15 Plaintiffs made a similar request for additional interrogatories in the Rule 26(f) Report, Joint Case
16 Management Statement, And Proposed Order submitted to Judge Wilken. (See Exh. A hereto, at
17 11.) However, after considering the request, Judge Wilken issued a Case Management Order that
18 granted *no additional interrogatories whatsoever*. (See Exh. B.) Instead, Judge Wilken left
19 unchanged the process for resolving claim construction set forth in the Patent Local Rules as
20 described above.

21 Defendants believe that the procedure for resolving claim construction ordered by Judge
22 Wilken and set forth in the Patent Local Rules is the procedure that should be adopted for this
23 case, not the burdensome and unusual process suggested by Plaintiffs.

24 **V. CONCLUSION**

25 Plaintiffs request extraordinary relief that requires essentially ignoring the local
26 rules. Further, the process for resolving claim construction Plaintiffs seek is far more likely to
27 create discovery disputes and distract from claim construction than it is to actually narrow the
28

1 issues in this case. The far more sensible and more common approach to claim construction is the
2 approach set forth in Rule 4 of the Northern District of California Patent Local Rules—the very
3 rules Defendants have already suggested the Court adopt in their previous proposed scheduling
4 orders and discovery plans. This is the process ordered by Judge Wilken in the California case
5 and Defendants respectfully request that this Court take a similar approach. Accordingly,
6 Defendants respectfully request that Plaintiffs' Motion should be denied in its entirety.

7 Respectfully submitted this 13th day of February, 2007.

8

9

10

11

12

13

14

15

16

17

18

19

20

21

22

23

24

25

26

27

28

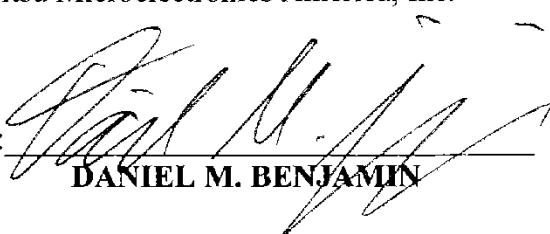
**CALVO & CLARK, LLP
MILBANK, TWEED, HADLEY
& MCCLOY LLP**

Attorneys for Defendants

Fujitsu Limited and

Fujitsu Microelectronics America, Inc.

By:



DANIEL M. BENJAMIN